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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,639	11/25/2003	Vernon Thomas Jensen	33-XZ-5706	5626
23446	7590	07/02/2009		
MCANDREWS HELD & MALLOY, LTD 500 WEST MADISON STREET SUITE 3400 CHICAGO, IL 60661			EXAMINER	
			TAYLOR, NICHOLAS R	
		ART UNIT	PAPER NUMBER	
		2441		
		MAIL DATE		DELIVERY MODE
		07/02/2009		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/721,639	Applicant(s) JENSEN ET AL.
	Examiner Nicholas Taylor	Art Unit 2441

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 November 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 November 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1668)
 Paper No(s)/Mail Date 12/23/03; 11/24/03
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

1. Claims 1-20 have been examined and are rejected.

Specification

2. The specification should be updated to reflect the present status of application 09/649,071.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the "communication protocol" would reasonably be interpreted by one of ordinary skill in the art as failing to fall within a statutory category of invention, because applicant's disclosure fails to disclose anything other than a purely software embodiment of the claimed communication protocol, and no other hardware context is given in the claimed embodiment.

Thus, in the context of the disclosure and claims in question, one of ordinary skill in the art would reasonably interpret the claimed subject matter to encompass intangible embodiments. As such, the claimed invention is not limited to a process, machine, manufacture, or composition of matter. Thus, the claimed limitations are not limited to statutory subject matter and are therefore nonstatutory.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garland et al. (U.S. PGPub 2002/0023067) and Simon et al. (U.S. Patent 6,470,207).

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

As per claim 1 and 14, Garland teaches a method for communication in a bi-directional diagnostic imaging system between a medical imaging subsystem and a medical navigational subsystem, the method comprising: (Garland, see paragraphs 0035-0040 and figs. 1 and 2)

realizing in a navigation subsystem a plurality of navigation subsystem to imaging subsystem messages; (Garland, see paragraphs 0035-0040 and figs. 1 and 2)

realizing in the imaging subsystem a Begin Imaging and an End Imaging message for synchronizing image acquisition with navigation coordinate determination, the Begin Imaging and End Imaging messages included in imaging subsystem to navigation subsystem messages; and formatting the End Imaging message according to a predetermined message header format common to a plurality of the navigation subsystem to imaging subsystem messages and the imaging subsystem to navigation subsystem messages; and (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used)

transmitting the End Imaging message from the imaging subsystem to the navigation subsystem (Garland, see paragraphs 0035-0040 and figs. 1 and 2).

However, Garland is silent as to combining navigation coordinate determination with the image acquisition process.

Simon teaches a fluoroscopic imaging system that synchronizes image acquisition with navigation coordinate determination in a networked imaging system (see fig. 1, fig. 4, and col. 8, line 47 to col. 9, line 50).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have combined Garland and Simon to provide the system of Simon in the system of Garland because doing so would provide an imaging system that enhances traditional surgical navigation techniques by providing navigational imaging guidance while performing surgery (Simon, see col. 1, lines 19-46).

As per claims 2 and 20, Garland-Simon teaches the system further comprising transmitting a magnification mode message specifying a magnification mode of an X-ray detector (Garland, see paragraphs 0077, 0089, and fig. 5c).

As per claim 3, Garland-Simon teaches the system further wherein the magnification mode specifies one of a 12 inch, 9 inch, and 6 inch magnification mode for a 12 inch image intensifier or one of a 9 inch, 6 inch, and 4.5 inch magnification mode for a 9 inch image intensifier (Garland, see paragraphs 0077, 0089, and fig. 5c).

As per claim 4, Garland-Simon teaches the system further wherein the navigation subsystem to imaging subsystem messages include an image request message, the imaging subsystem to navigation subsystem messages include an image reply message, and the image reply message comprises image width, image height, and pixel data (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used).

As per claim 5, Garland-Simon teaches the system further wherein the image reply message further comprises bytes-per-pixel, field of view, and image rotation (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used).

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As per claim 6, Garland-Simon teaches the system further wherein at least one of the navigation subsystem to imaging subsystem messages and the imaging subsystem to navigation subsystem messages include a Ping response time message (Garland, paragraphs 0035-0054, 0056, and 0059).

As per claim 7, Garland-Simon teaches the system further wherein the navigation subsystem to imaging subsystem messages include a system configuration request message (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used).

As per claim 8, Garland-Simon teaches the system further wherein the imaging subsystem to navigation subsystem messages include a system configuration reply message (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used).

As per claim 9, Garland-Simon teaches the system further wherein the system configuration reply message comprises a system model and software revision (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used).

As per claim 10, Garland-Simon teaches the system further wherein the navigation subsystem to imaging subsystem messages include a file request message specifying a

filename to transfer (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used).

As per claim 11, Garland-Simon teaches the system further wherein the imaging subsystem to navigation subsystem messages include a file reply message with responsive data from a file identified by the filename (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used).

As per claim 12, Garland-Simon teaches the system further wherein the imaging subsystem to navigation subsystem messages include a patient information message specifying at least patient name, sex, and patient ID (Garland, see, e.g., fig. 5A).

As per claim 13, Garland-Simon teaches the system further wherein the imaging subsystem to navigation subsystem messages include a navigation subsystem network address selection message (Garland, see paragraphs 0035-0040 and figs. 1 and 2).

As per claim 15, Garland-Simon teaches the system further wherein transmitting comprises transmitting over a high speed network connection (Garland, paragraph 0035).

As per claim 16, Garland-Simon teaches the system further wherein transmitting comprises transmitting over an Ethernet network connection (Garland, paragraph 0035).

As per claim 17, Garland-Simon teaches the system further wherein transmitting comprises transmitting according to the TCP/IP protocol (Garland, see paragraphs 0056 and 0059).

As per claim 18, Garland-Simon teaches the system further comprising:

formatting an image request message according to the predetermined message header format; transmitting the image request message from the imaging subsystem to the navigation subsystem; formatting an image reply message according to the predetermined message header format; and transmitting the image reply message with image data from the imaging subsystem to the navigation subsystem (Garland, see paragraphs 0012, 0055, 0056, 0059, and 0065, where the DICOM 3.0 standard is used).

As per claim 19, Garland-Simon teaches the system further wherein transmitting comprises transmitting across a private network between the navigation subsystem and the imaging subsystem (Garland, see paragraphs 0035-0040 and figs. 1 and 2).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas Taylor whose telephone number is (571) 272-3889. The examiner can normally be reached on Monday-Friday, 8:30am to 5:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wing Chan can be reached on (571) 272-7493. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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/NT/
Nicholas Taylor
Examiner
Art Unit 2441
/Larry D Donaghue/
Primary Examiner, Art Unit 2454